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10/766,632

01/28/2004

Louie V. Harrison III

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07/06/2006

WYATT, TARRANT & COMBS, LLP
1715 AARON BRENNER DRIVE
SUITE 800
MEMPHIS, TN 38120-4367

EXAMINER

KILKENNY, PATRICK J

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/766,632

Applicant(s)

HARRISON, LOUIE V.

Examiner

Patrick J. Kilkenney

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 28-45 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-27, drawn to unit package for curable dental composites, classified in class 433, subclass 08.
- II. Claims 28-45, drawn to a method of apply aesthetic dental restorations from a dental unit package, classified in class 433, subclass 226.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product. See MPEP § 806.05(h). In the instant case the methods of applying aesthetic dental restorations can be utilized with another dental restoration in another unit package.

During a telephone conversation with Roy Berkenstock on 6/20/2006 a provisional election was made without traverse to prosecute the invention of I, claims 1-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 28-45 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11 and 12 recites the limitations "the outer strip" in line 1 of each claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 4-8 and 10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Wiesel (6,343,932). Wiesel discloses a unit package for carrying and applying a dental composite (Column 6, lines 5-18). The dental composite (16) is carried on a carrier film (12) that is covered by a film covering (18) that is releasably sealed to the carrier film adjacent the composite (Figs. 1 and 2). The cover is in direct

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contact with the composite and is designed with a surface of non-adhesive release material (Column 4, lines 53-58), and it is also disclosed that a non-adhesive release coating may be applied for easier release (Column 5, lines 1-4). The carrier film has laterally extending tabs (22 and 24) that are able to fold under the central portion of the carrier film and wrap around the edges of the teeth with applied (Figs. 2 and 3). The unit packages can be made singly, or come in a plurality of adjacent packages in a long roll that can be individually cut out when needed (Column 3, lines 60-64). The carrier film can be translucent if light activation of the applied composite is necessary (Column 4, lines 21-24). The unit package also includes an outer strip (20), on which the carrier strip is disposed, and is releasably sealed to the adjacent cover.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel in view of Davie, Jr. et al. (4,125,190). Wiesel discloses the claimed invention with the exception of the cover being dome-like in shape and not being in direct contact with the composite. Davie, Jr. et al. discloses a cover (14) that is adjacent to and encloses carrying film (20) and is dome-like in shape and does not contact the

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substance (24) held within the defined pocket. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the cover of Wiesel with a dome-like cover that does not contact the dental composite, as taught by Davie, Jr. et al., so that the dental composite would not stick to the cover, and the use of non-adhesive cover materials or non-adhesive coatings could be eliminated from the design, which would decrease the complexity and price of manufacturing the unit package.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel. Wiesel discloses the claimed invention with the exception of having a third tab that is capable of folding under the central portion of the carrier film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of Wiesel having a plurality of tabs, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 13 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel in view of Jacobs et al. (5,762,192). Wiesel discloses the claimed invention with the exception of using an cover that is opaque to actinic radiation that would cure a dental composite. Jacobs et al. discloses a packaging for curable materials (specifically for dental use) that is actinic to radiation that would cure said materials (see abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the cover of Wiesel by making it actinic to radiation, as

taught by Jacobs et al., so the dental composite held within would not be activated before use.

Claims 14-15 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel in view of Jacobs et al. as applied to claims 13 and 19 above, and further in view of Davie Jr. et al. Wiesel in view of Jacobs et al. discloses the claimed invention with the exception of the cover being dome-like in shape and not being in direct contact with the composite. Davie, Jr. et al. discloses a cover (14) that is adjacent to and encloses carrying film (20) and is dome-like in shape and does not contact the substance (24) held within the defined pocket. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made, to modify the cover of Wiesel in view of Jacobs et al. with a dome-like cover that does not contact the dental composite, as taught by Davie, Jr. et al., so that the dental composite would not stick to the cover, and the use of non-adhesive cover materials or non-adhesive coatings could be eliminated from the design, which would decrease the complexity and price of manufacturing the unit package.

Wiesel in view of Jacobs et al. also does not disclose having a third tab that is capable of folding under the central portion of the carrier film. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the assembly of Wiesel in view of Jacobs et al. having a plurality of tabs, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel in view of Jacobs et al., in further view of Davie Jr. et al, as applied to claim 14 above, and further in view of Sawhney et al. (5,947,278). Wiesel in view of Jacobs et al. discloses the claimed invention with the exception of there being perforation between the unit packages. Sawhney et al. discloses packaged cups for dental compositions with perforations (182) between the individual packages. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the unit package of Wiesel in view of Jacobs et al., in further view of Davies, Jr. et al. with perforations between the unit packages, as taught by Sawhney et al., so the individual packages could be easily removed without having to use a cutting device.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wiesel in view of Jacobs et al. as applied to claim 26 above, and further in view of Sawhney et al. (5,947,278). Wiesel in view of Jacobs et al. discloses the claimed invention with the exception of there being perforation between the unit packages. Sawhney et al. discloses packaged cups for dental compositions with perforations (182) between the individual packages. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the unit package of Wiesel in view of Jacobs et al. with perforations between the unit packages, as taught by Sawhney et al., so the individual packages could be easily removed without having to use a cutting device.

Conclusion

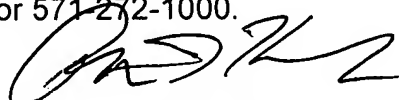
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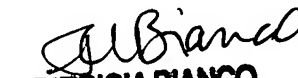
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for prior art of reference. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J. Kilkenny whose telephone number is (571) 272-8684. The examiner can normally be reached on Mon-Fri, 8-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


PJK


Patrick J. Kilkenny
Art Unit 3732
June 23, 2006
6/23/06


PATRICIA BIANCO
PRIMARY EXAMINER
6/26/06